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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Arnold Gieseke

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EXAMINER

NGUYEN, CUONG H

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/531,338	Applicant(s) GIESEKE, ARNOLD	
	Examiner CUONG H. NGUYEN	Art Unit 3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/04/09 (THE AMENDMENT).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,14,17-19,32,33,35-37,39-43 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,14,32,37 and 39 is/are rejected.
- 7) ☒ Claim(s) 4-6,17-19,33,35,36,42,43 and 45 is/are objected to.
- 8) ☒ Claim(s) 40 and 41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/12/09</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. This Office Action is the answer to a communication filed on 1/23/2009.
2. Claims 1, 4-6, 14, 17-19, 32-33, 35-37, 39-43, and 45 are pending in this application.
wherein claims 34, 44 are withdrawn.

Remark

3. Independent claim 32 contains broadest limitations among pending claims; it only requires a well-known navigation server comprises fundamental components to do modifications (such as on a widely-used GPS device to change a vehicle's icon – e.g., see Garmin Nuvii 740's features).

Claim Objection

4. According to Claims 40- 41's meanings (not amended), there are 2 different species because they both are dependent on claim 1 (generally storing/claim 40, and "specific" storing/claim 41) – explanation is requested (otherwise, pending claim 41 should be depending on claim 40).
5. Claims 35-36 provide no further limitation from claim 32 (they contain limitations which are not belonging to a claimed system comprising physical components).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the

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international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

6. Claims 32, 37, and 39 are rejected under 35 U.S.C. § 102(e) as being anticipate by Khavakh et al. (US Pub. 20030028319).

A. As to claim 32:

Khavakh et al. teach a navigation system (see Khavakh et al., FIG. 1, ref. 10), comprising:

- a navigation server comprising a processor 12 and a memory 16, where the memory 16 includes instructions executable by the processor 12 to:
 - calculate a first route to a trip destination (see Khavakh et al., FIG. 4, ref. 40, 50), where the first route is generated on a road network map that includes a plurality of map elements (see Khavakh et al., FIG. 12);
 - receive a user modification (see Khavakh et al., FIG. 1, ref. “USER INTERFACE 31”), of the first route where the user modification includes selection of at least one map element (i.e., selecting “SHORTEST DISTANCE” OR “SHORTEST TRAVEL TIME”);
 - calculate a second route to the trip destination as a function of the user modification from that modification; and
 - transmit the second route to a vehicle navigation system (i.e., driver’s navigation device receives signals by wireless transmission via antenna - (see Khavakh et al., FIG. 1).

B. As to claims 37, and 39:

Besides claim 32 limitations, Khavakh et al. suggest:

an adaptive route calculation module operable to receive a user modification of the first route from the input device, where the user modification includes selection of at least one map element in the road network map (see Khavakh et al., FIG. 4, ref. 40, 50), where a second route is calculated by the adaptive route calculation module as a function of the user modification (i.e., a rerouting calculation, see Khavakh et al., para. [0187]-[0188], [0193]); where the adaptive route calculation module is operable to determine differences between the first route and the second route (i.e., a displayed easy-to-recognized result from each selection), and where differences between the first route and the second route are transmitted to a vehicle navigation system.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7 Claims 1, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khavakh et al. (US Pub. 20030028319), in view of Morita (US Pat. 6,119,095).

All the claims' physical components that making-up these claims' systems are already showed as above. Morita (see Figs. 1-3) further defines structure 10 that covers claimed components with particular features.

It would have been obvious to one of ordinary skill in the art at the time of invention was made to implement Khavakh et al. with Morita's ideas to suggest a navigation system having physical components as claimed to explain each component's functioning.

Election/Restrictions

8. Applicant is required under 35 U.S.C. 121 to elect one of the disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, un-patentable claim 32 appears as a generic claim.

- Species I: A claimed system having a feature of: "... the second route is stored in the vehicle navigation system" (see claim 40, lines 1- 2).

- Species II: A claimed system having a feature of: "...the second route is stored in the vehicle navigation system as a preferred route" (see claim 40, lines 1- 2; the underlined terms requires a specific "sub-species" that not required for species I – in another word, they split into different requirements/limitations).

. Applicant is requested to elect species I or II for examination.

9. Applicant is advised that a reply to the species election requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct,

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applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Remark: Pending claims are about an physical system; therefore, a system must be distinguished from the prior art in terms of structure of its components rather than function. In re Danly 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987) - the claimed functions are immaterial to the structure of claimed apparatus/system.

If system claims contain functional recitations: The functional recitation that has not been given patentable weight because they are in narrative form(s). In order to be given a patentable weight, a functional recitation MUST BE EXPRESSED as a "means" for performing the specified function, as set forth in 35 USC 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language

(see In re Fuller, 1929 C.D. 172, 388 O.G. 279).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN (email address: cuong.nguyen@uspto.gov) whose telephone number is 571-272-6759. The examiner can normally be reached on 8:30 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6759.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

/CUONG H. NGUYEN/
Primary Examiner